

RECEIVED
CENTRAL FAX CENTER

MAR 29 2006

OFFICIAL

CARDINAL LAW GROUP

1603 Orrington Avenue/Suite 2000
Evanston, Illinois 60201
Telephone 847 - 905 - 7111
Facsimile 847 - 905 - 7113

Date: MARCH 29, 2006

To: EXAMINER WANG, LIANG
U.S. PATENT AND TRADEMARK OFFICE
Fax #: (571) 273-8300

From: FRANK C. NICHOLAS
Phone #: (847) 424-2521

Client/Matter No.: AUS920010982US1 (9000/86)

of Pages: 19
(including cover sheet)

IF YOU HAVE ANY PROBLEMS RECEIVING THIS MESSAGE, PLEASE CALL 847/905-7111, Ext. 112 AND ASK FOR JENNIFER CRUZ.

THIS MESSAGE IS INTENDED ONLY FOR THE INDIVIDUAL OR ENTITY TO WHICH IT IS ADDRESSED. IT MAY CONTAIN PRIVILEGED, CONFIDENTIAL, ATTORNEY WORK PRODUCT, OR TRADE SECRET INFORMATION WHICH IS EXEMPT FROM DISCLOSURE UNDER APPLICABLE LAWS. IF YOU ARE NOT THE INTENDED RECIPIENT, OR AN EMPLOYEE OR AGENT RESPONSIBLE FOR DELIVERING THE MESSAGE TO THE INTENDED RECIPIENT, YOU ARE HEREBY NOTIFIED THAT ANY DISSEMINATION, DISTRIBUTION, OR COPYING OF THIS MESSAGE IS STRICTLY PROHIBITED. IF YOU HAVE RECEIVED THIS MESSAGE IN ERROR, PLEASE NOTIFY US IMMEDIATELY BY TELEPHONE AND RETURN THE ORIGINAL MESSAGE (AND ALL COPIES) TO US BY MAIL AT THE ABOVE ADDRESS. WE WILL REIMBURSE YOU FOR POSTAGE.

**RECEIVED
CENTRAL FAX CENTER**

MAR-29-06 03:53PM FROM-CLG FAX

MAR 29 2006

+18479057113

T-281 P.02 F-716

PTO/SB/21 (12-07) Approved to use through 3/30/00 GMB 0651-0031 Patent and Trademark Office U.S. DEPARTMENT OF COMMERCE
Under the Paper Reduction Act of 1995 no person is required to respond to a collection of information unless it displays a valid OMB control number.

**TRANSMITTAL
FORM**

(to be used for all correspondence after initial filing)

Attorney Docket No	AUS920010982US1 (9000/86)
Application Number	10/042,480
Filing Date	JANUARY 9, 2002
First Named Inventor	PHILIP Y. CHANG
Group Art Unit	2155
Examiner	WANG, LIANG C. A.

ENCLOSURES (check all that apply)

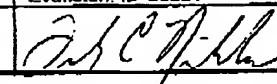
<input type="checkbox"/> Amendment	<input type="checkbox"/> Assignment Papers	<input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences
<input type="checkbox"/> After Final	<input type="checkbox"/> Drawing Sheets	<input checked="" type="checkbox"/> Appeal Brief
<input type="checkbox"/> Affidavits/declaration(s)	<input type="checkbox"/> After Allowance Communication to Group	<input type="checkbox"/> Proprietary Information
<input type="checkbox"/> Status Letter	<input type="checkbox"/> Petition Routing Slip (PTO/SB/69) and Accompanying Petition	<input type="checkbox"/> Post Card Receipt
<input type="checkbox"/> Petition for Extension of Time Request (dup)	<input type="checkbox"/> To Convert a Provisional Application	<input type="checkbox"/> Additional Enclosure(s) (please identify below).
<input type="checkbox"/> Express Abandonment Request	<input type="checkbox"/> Change of Correspondence Address	<input type="checkbox"/>
<input type="checkbox"/> Information Disclosure Statement, PTO-1449	<input type="checkbox"/> Terminal Disclaimer	<input type="checkbox"/>
<input type="checkbox"/> Certified Copy of Priority Document(s)	<input type="checkbox"/> Small Entity Statement	<input type="checkbox"/>
<input type="checkbox"/> Response to Missing Parts/ Incomplete Application	<input type="checkbox"/> Request of Refund	<input type="checkbox"/>
<input checked="" type="checkbox"/> The Commissioner is hereby authorized to charge any fees which may be required, or credit any overpayment, to Deposit Account No. 09-0447 (IBM CORPORATION). A duplicate copy of this sheet is enclosed.		
<input checked="" type="checkbox"/> I hereby petition under 37 CFR § 1.138(a) for any extension of time required to ensure that this paper is timely filed. Please charge any associated fees which have not otherwise been paid to Deposit Account No. 09-0447 (IBM CORPORATION). A duplicate copy of this sheet is enclosed.		

CALCULATION OF FEE

	Claims After Amendment		Highest No Previously Paid For	Present Extra	Small Entity		Large Entity	
					Rate	Add'l Fee	Rate	Add'l Fee
Total		Minus		0	x \$25=	0	x \$50=	
Indep		Minus		0	x \$100=	0	x \$200=	
First Presentation of Multiple Dep. Claim					+ \$180=	—	+ \$360=	
					total add'l fee	\$ 0	total add'l fee	\$ 0

SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

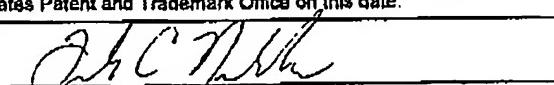
Firm or Individual name	FRANK C. NICHOLAS Registration No. 33,983 CARDINAL LAW GROUP 1803 Orrington Avenue, Suite 2000 Evanston, IL 60201
-------------------------	---

Signature  Date March 29, 2006

CERTIFICATE OF FACSIMILE

I hereby certify that this correspondence is being transmitted via facsimile to (571) 273-8300 to the United States Patent and Trademark Office on this date.

March 29, 2006

Signature	 FRANK C. NICHOLAS (33,983)	Date. March 29, 2006
-----------	---	----------------------

**RECEIVED
CENTRAL FAX CENTER**

MAR-29-06 03:53PM FROM-CLG FAX

MAR 29 2006 +18479057113

T-281 P.03/19 F-716

PTO/FGB/21 112-971 Approved by the U.S. Patent and Trademark Office. U.S. DEPARTMENT OF COMMERCE
Under the Paper Reduction Act of 1995, no person is required to respond to or collect information unless it displays a valid OMB control number.

**TRANSMITTAL
FORM**

(to be used for all correspondence after filing)

Attorney Docket No	AUS82001D982US1 (9000/86)
Application Number	10/042,480
Filing Date	JANUARY 9, 2002
First Named Inventor	PHILIP Y. CHANG
Group Art. Unit	2155
Examiner	WANG, LIANG C. A.

ENCLOSURES (check all that apply)

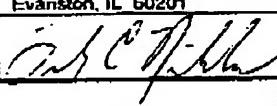
<input type="checkbox"/> Amendment	<input type="checkbox"/> Assignment Papers	<input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences
<input type="checkbox"/> After Final	<input type="checkbox"/> Drawing Sheets	<input checked="" type="checkbox"/> Appeal Brief
<input type="checkbox"/> Affidavits/declaration(s)	<input type="checkbox"/> After Allowance Communication to Group	<input type="checkbox"/> Proprietary Information
<input type="checkbox"/> Status Letter	<input type="checkbox"/> Petition Rowing Slip (PTO/SB/69) and Accompanying Petition	<input type="checkbox"/> Post Card Receipt
<input type="checkbox"/> Petition for Extension of Time Request (dup)	<input type="checkbox"/> To Convert a Provisional Application	<input type="checkbox"/> Additional Enclosure(s) (please identify below):
<input type="checkbox"/> Express Abandonment Request	<input type="checkbox"/> Change of Correspondence Address	<input type="checkbox"/>
<input type="checkbox"/> Information Disclosure Statement, PTO-1449	<input type="checkbox"/> Terminal Disclaimer	<input type="checkbox"/>
<input type="checkbox"/> Certified Copy of Priority Document(s)	<input type="checkbox"/> Small Entity Statement	<input type="checkbox"/>
<input type="checkbox"/> Response to Missing Parts/ Incomplete Application	<input type="checkbox"/> Request of Refund	<input type="checkbox"/>
<input checked="" type="checkbox"/> The Commissioner is hereby authorized to charge any fees which may be required, or credit any overpayment, to Deposit Account No 09-0447 (IBM CORPORATION). A duplicate copy of this sheet is enclosed.		
<input checked="" type="checkbox"/> I hereby petition under 37 CFR § 1.138(a) for any extension of time required to ensure that this paper is timely filed. Please charge any associated fees which have not otherwise been paid to Deposit Account No 09-0447 (IBM CORPORATION). A duplicate copy of this sheet is enclosed.		

CALCULATION OF FEE

	Claims After Amendment		Highest No Previously Paid For	Present Extra	Small Entity		Large Entity	
					Rate	Add'l Fee	Rate	Add'l Fee
Total		Minus		0	x \$25=	0	x \$50=	
Indep		Minus		0	x \$100=	0	x \$200=	
First Presentation of Multiple Dep. Claim					+\$180=	—	+ \$360=	
					total add'l fee	\$ 0	total add'l fee	\$ 0

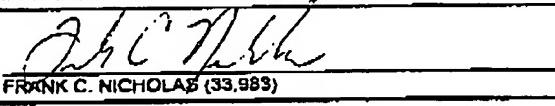
SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

Firm or Individual name	FRANK C. NICHOLAS Registration No. 33,983 CARDINAL LAW GROUP 1803 Orrington Avenue, Suite 2000 Evanston, IL 60201
-------------------------	---

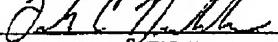
Signature		Date	March 29, 2006
-----------	---	------	----------------

CERTIFICATE OF FACSIMILE

I hereby certify that this correspondence is being transmitted via facsimile to (571) 273-8300 to the United States Patent and Trademark Office on this date.	March 29, 2006
---	----------------

Signature		Date:	March 29, 2006
FRANK C. NICHOLAS (33,983)			

Certificate of Facsimile
I hereby certify that this correspondence is being
transmitted by facsimile to (571) 273-8300 to the U.S.
Patent and Trademark Office March 29, 2006
(Date of Transmission)

FRANK C. NICHOLAS (33 983)
Name of applicant, assignee or registered representative

Signature
March 29, 2006
Date of Signature

**RECEIVED
CENTRAL FAX CENTER**

MAR 29 2006

PATENT
Case No. AUS920010982US1
(9000/86)

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re parent application of:)
PHILIP Y. CHANG, ET. AL.) Examiner: WANG, LIANG
Serial No.: 10/042,480)
Filed: JANUARY 9, 2002) Group Art Unit: 2155
Title: AUTOMATION AND DYNAMIC)
MATCHING OF BUSINESS TO)
BUSINESS PROCESSES) Conf. No: 6093

APPEAL BRIEF

Mail Stop Appeal Briefs - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

Appellants herewith respectfully present their appeal brief as follows:

March 29, 2006
Case No. AUS920010982US1 (9000/86)
Serial No.: 10/042,480
Filed: January 9, 2002
Page 2 of 16

TABLE OF CONTENTS

1.	Real Party In Interest	3
2.	Related Appeals And Interferences	4
3.	Status Of Claims	5
4.	Status Of Amendments	6
5.	Summary Of Claimed Subject Matter.	7
6.	Grounds Of Rejection To Be Reviewed On Appeal	8
7.	Arguments	9
8.	Summary	12
	Claims Appendix	13
	Evidence Appendix	16
	Related Proceedings Appendix	16

March 29, 2006
Case No. AUS920010982US1 (9000/86)
Serial No.: 10/042,480
Filed: January 9, 2002
Page 3 of 16

I. REAL PARTY IN INTEREST

The real party in interest is Assignee INTERNATIONAL BUSINESS
MACHINES CORPORATION, by virtue of an assignment executed by the inventors.

March 29, 2006
Case No. AUS920010982US1 (9000/86)
Serial No.: 10/042,480
Filed: January 9, 2002
Page 4 of 16

2. RELATED APPEALS AND INTERFERENCES

Appellants and the undersigned attorneys are not aware of any appeals or any interferences which will directly affect or be directly affected by or having a bearing on the Board's decision in the pending appeal.

March 29, 2006
Case No. AUS920010982US1 (9000/86)
Serial No.: 10/042,480
Filed: January 9, 2002
Page 5 of 16

3. STATUS OF CLAIMS

Claims 1-17 stand rejected under the judicially created doctrine of double patenting.

Claims 1-17 stand rejected as anticipated by Albaugh, et. al., United States Patent Publication No. 2003/0115182 ("Albaugh").

Claims 1-17 are the claims on appeal. See, Appendix.

MAR-29-06 03:54PM FROM-CLG FAX

+18479057113

T-281 P.09/19 F-716

March 29, 2006
Case No. AUS920010982US1 (9000/86)
Serial No.: 10/042,480
Filed: January 9, 2002
Page 6 of 16

4. STATUS OF AMENDMENTS

No amendments have been made or entered.

March 29, 2006
Case No. AUS920010982US1 (9000/86)
Serial No.: 10/042,480
Filed: January 9, 2002
Page 7 of 16

5. SUMMARY OF CLAIMED SUBJECT MATTER

In this summary of claimed subject matter, all citations are to the specification of United States Patent Application 10/042,480 filed on January 9, 2002. Further, all citations are illustrative only and support for the cited element may be found elsewhere in the specification.

The invention relates to a method of automating the matching of business to business processes including receiving transmission capability from a first company 61 and a second company 62, storing transmission capabilities 63, receiving a request from one of the first and second companies to do business with the other company 64, and determining at least one translation path between the first and second companies based on the transmission capabilities and translation capabilities 65. See, e.g. FIG. 2 and pages 4 and 5 of the specification, ¶¶13-15 of United States Patent Publication 2003/0131120.

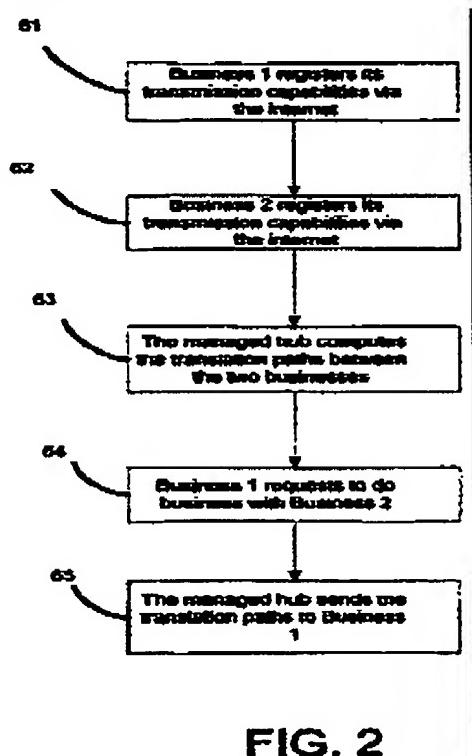


FIG. 2

March 29, 2006
Case No. AUS920010982US1 (9000/86)
Serial No.: 10/042,480
Filed: January 9, 2002
Page 8 of 16

6. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

Claims 1-17 were rejected under the judicially created doctrine of double patenting over Albaugh '551.

Claims 1-17 were rejected as anticipated by Albaugh '551.

March 29, 2006
Case No. AUS920010982US1 (9000/86)
Serial No.: 10/042,480
Filed: January 9, 2002
Page 9 of 16

7. ARGUMENTS

A. Claims 1-17 were provisionally rejected under the judicially created doctrine of double patenting over Application 10/015,234.

The provisional double patenting rejection of claims 1-17 is traversed. Appellants note that Application 10/015,234 issued as United States Patent 6,912,551B2 on June 28, 2005. Appellants will address the rejections based on the '551 patent.

Rejections of claims under the judicially created doctrine of double patenting must be made so as to prevent the unjustified or improper timewise extension of the right to exclude. Such a goal is only attained if the claims are not independent and distinct. See, MPEP §804. A double patenting rejection of this type is analogous to a §103 rejection, and therefore the analysis parallels the guidelines for analysis of a §103 rejection. MPEP §804.

Claims 1-17 are independent and distinct from claims 1-17 of Albaugh '551, as the claims of the '551 patent do not include "transmission capability" as claimed in claims 1, 8, and 15 of the instant application, as well as claims 2-7, 9-14, and 16-17 depending therefrom. A prior art reference that renders claimed subject matter obvious under 35 U.S.C. 102(e)/ 103(a) does not create a double patenting situation where that subject matter is *not claimed in the reference patent*. See, MPEP §804 ¶III. The instant claims do not claim common subject matter, in contrast to the Examiner's argument of ¶5 of the May 26, 2005 Office Action.

Additionally, for applications pending on or after December 10, 2004 (such as this), rejections under 35 U.S.C. 102(e)/103(a) should not be made or maintained if the reference is disqualified under 35 U.S.C. 103(c) as prior art in a 35 U.S.C. 103(a) rejection. See, MPEP §804 ¶III. Thus, because Albaugh '551 could not be cited in a §103(a) rejection under §103(c), Albaugh '551 should not be cited as an obviousness type double patenting.

In response to the Examiner's statement that there is no apparent reason why Appellants would be prevented from presenting the instant claims in the '551 patent, Appellants note that the '551 patent has issued. See, ¶7 of the November 25, 2005 office action.

Withdrawal of the double patenting rejection is requested.

March 29, 2006
Case No. AUS920010982US1 (9000/86)
Serial No.: 10/042,480
Filed: January 9, 2002
Page 10 of 16

B. Claims 1-17 were rejected under 35 U.S.C. §102(e) as anticipated by Albaugh '551

The §102(e) rejections of claims 1-17 as anticipated by Albaugh '551 is traversed. In order to sustain the rejection, each and every element of the claimed invention must be disclosed by the reference in at least as great detail as claimed. Since the reference does not disclose each and every element, the rejection should be withdrawn. Appellants note that they are well familiar with the disclosures of Albaugh '551, as they are the named inventors of Albaugh '551 as well as the instant application.

Albaugh '551 does not disclose receiving transmission capability from a first company and a second company and storing transmission capabilities, as claimed in claims 1, 8, and 15. The Examiner's citations to ¶37 (column 4, lines 11-19 of '551) and FIG. 1 of Albaugh '551 are misplaced. That selection discloses only:

[0037] If the initiator and target participant are identified trading partners, decision 330 branches to "Yes" branch 332 whereupon a determination is made as to whether the trading partners have a known transaction process which links, or translates, the initiator's business process to the target participant's process (decision 335). In one embodiment, the target participant's member profile includes the transaction process which links the initiator's business process and the target participant's business process.

The Examiner's allegation that the "business process" is the same as the claimed transmission capability is misplaced. See, ¶¶3a and 10 of the November 25, 2005 office action. While the Examiner correctly notes that information must be received in order to be stored into the member profile, such fact does not disclose that the information being stored is the claimed "transmission capability." It is well settled that the identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). Without a disclosure of the claimed "transmission capability" or evidence that one of ordinary skill in the art would confuse the same with the disparate "business process" or "transaction process", this anticipation rejection fails.

March 29, 2006
Case No. AUS920010982US1 (9000/86)
Serial No.: 10/042,480
Filed: January 9, 2002
Page 11 of 16

The Examiner provides no evidence that one of ordinary skill in the art could confuse "business process" or "transaction process" with the claimed transmission capability. Indeed, the disclosure of Albaugh '551 indicates that the determination of whether there is a known transaction process linking the initiator and target only occurs if the initiator and target are identified trading partners. Simply substituting the claimed "transmission capability" in the above citation renders the paragraph devoid of meaning.

Furthermore, since the inventive entities of the Albaugh '551 reference and the instant application are identical, any unclaimed invention disclosed in Albaugh '551 was derived from the inventors of the current application. Therefore, Albaugh '551 is not a proper §102(e) reference. See, MPEP §§716.10, 804 ¶III, and *In re Katz*, 687 F.2d 450.

Claims 2-7, 9-14, and 16-17 depend from one of claims 1, 8, or 15 and are therefore patentable over Albaugh '551 for at least the same reasons.

Withdrawal of the §102(e) rejections to claims 1-17 is requested.

March 29, 2006
Case No. AUS920010982US1 (9000/86)
Serial No.: 10/042,480
Filed: January 9, 2002
Page 12 of 16

SUMMARY

The Appellants respectfully submit that claims 1-17 fully satisfy the requirements of 35 U.S.C. §§101, 102, 103 and 112. In view of the foregoing, favorable consideration and early passage to issue of the present application is respectfully requested.

Dated: March 29, 2006

Respectfully submitted,
PHILIP Y. CHANG, et al.



FRANK C. NICHOLAS,
Registration No. (33,983)
Attorney for Appellants

CARDINAL LAW GROUP
1603 Orrington Avenue, Suite 2000
Evanston, IL 60201
(847) 905-7111

March 29, 2006
Case No. AUS920010982US1 (9000/86)
Serial No.: 10/042,480
Filed: January 9, 2002
Page 13 of 16

10. APPENDIX

- 1. A method of automating the matching of business to business processes comprising:**
 - receiving transmission capability from a first company and a second company;**
 - storing transmission capabilities;**
 - receiving a request from one of the first and second companies to do business with the other company; and**
 - determining at least one translation path between the first and second companies based on the transmission capabilities and translation capabilities.**
- 2. The method of claim 1 wherein the transmission capabilities represent process formats supported by each company.**
- 3. The method of claim 2 further comprising storing transmission capabilities in a managed hub.**
- 4. The method of claim 1 wherein the translation capabilities represent mapping from one data format to another.**
- 5. The method of claim 4 further comprising storing the translation capabilities in a managed hub.**
- 6. The method of claim 1 wherein the request from one of the first and second companies is regarding any business to business computer transaction.**

March 29, 2006
Case No. AUS920010982US1 (9000/86)
Serial No.: 10/042,480
Filed: January 9, 2002
Page 14 of 16

7. The method of claim 1 wherein the translation path represents a number of data transformation and process translation capabilities.

8. A computer usable medium containing computer readable code for automating the matching of business to business processes comprising:

computer readable code for receiving transmission capability from a first company and a second company;

computer readable code for storing transmission capabilities;

computer readable code for receiving a request from one of the first and second companies to do business with the other company; and

computer readable code for determining a translation path between the first and second companies based on the transmission and translation capabilities.

9. The computer usable medium of claim 8 wherein transmission capabilities represent process formats supported by each company.

10. The computer usable medium of claim 9 further comprising storing transmission capabilities in a managed hub.

11. The computer usable medium of claim 8 wherein the translation capabilities represent mapping from one data format to another.

12. The computer usable medium of claim 11 further comprising storing the translation capabilities in the managed hub.

March 29, 2006
Case No. AUS920010982US1 (9000/86)
Serial No.: 10/042,480
Filed: January 9, 2002
Page 15 of 16

13. The computer usable medium of claim 8 wherein the request from one of the first and second companies is regarding any business to business computer transaction.

14. The computer usable medium of claim 8 wherein the translation path represents a number of data transformation and process translation capabilities.

15. A system for automating the matching of business to business processes comprising:

means for receiving transmission capability from a first company and a second company;

means for storing transmission capabilities;

means for receiving a request from one of the first and second companies to do business with the other company; and

means for determining a translation path between the first and second companies based on the transmission and translation capabilities.

16. The system of claim 15 further comprising means for storing the transmission capabilities in a managed hub.

17. The system of claim 15 further comprising means for storing the translation capabilities in a managed hub.

MAR-29-06 03:56PM FROM-CLG FAX

+18479057113

T-281 P.19/19 F-716

March 29, 2006
Case No. AUS920010982US1 (9000/86)
Serial No.: 10/042,480
Filed: January 9, 2002
Page 16 of 16

Evidence Appendix

None

Related Proceedings Appendix

None.